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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,309	04/20/2004	Michael B. Zemel	31894-199326	2567
26694	7590	10/04/2005	EXAMINER	
VENABLE LLP			LASTRA, DANIEL	
P.O. BOX 34385			ART UNIT	
WASHINGTON, DC 20045-9998			PAPER NUMBER	

3622

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/827,309

Applicant(s)

ZEMEL ET AL.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892).
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/27/05;04/20/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 1-27 have been examined. Application 10/827,309 (METHODS OF PROMOTING CALCIUM CONSUMPTION FOR WEIGHT LOSS) has a filing date 04/20/2004 and is a division of 10066057 01/31/2002 is a division of 09654357 09/01/2000.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 and 5-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology within the recited steps of communicating the benefit of consuming calcium-containing product.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 1-3 and 5-24 are deemed to be directed to non statutory subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazer (US 5,698,222) in view of Hinz (US 6,403,657) and further in view of Tannehill (US 5,158,310).

As per claims 1, 22 and 24, Mazer teaches:

A method comprising communicating to a potential consumer that consuming a calcium-containing product may have a beneficial effect (see column 6, lines 44-56) but

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fails to teach the communicating being by an entity having a commercial interest in the consumption of the product. However, Tannehill teaches a system that delivers dairy advertisements to consumers in a retail store, the retail store having commercial interest in the sale of the product (see column 19, lines 1-15). Mazer fails to teach that said beneficial effect is on body weight or body fat. However, Hinz teaches a method of using calcium supplements to combat obesity (see Hinz abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that retailers of calcium-enriched products (such as dairy products), as taught by Tannehill would promote the consumption of said products by claiming that the consumption of said products would have a benefit against osteoporosis (see Mazer column 3, lines 30-50) and obesity (see Hinz abstract). Retailers of calcium-fortified products (i.e. fortified juices, fruit drinks, breads and cereals) such as the one taught by Tannehill would be motivated to advertise the benefits of said products in combating diseases and/or maladies, such as osteoporosis and/or obesity, as said advertise benefits would bring more business to said retailers.

As per claim 2, Mazer teaches:

The method of claim 1, wherein the communicating comprises providing information about suboptimal calcium consumption (see column 2, lines 39-60).

As per claim 3, Mazer teaches:

The method of claim 1, further comprising communicating an effect of calcium consumption on osteoporosis (see column 3, lines 30-50).

As per claims 4 and 25, Mazer teaches:

The method of claim 1, but fails to teach wherein the communicating is by a method selected from the group consisting of verbal communication, pamphlet distribution, print media, audio tapes, magnetic media, digital media, audiovisual media, billboards, advertising, newspapers, magazines, direct mailings, radio, television, electronic mail, electronic media, banner ads, and fiber optics. However, Official Notice is taken that it is old and well known in the business art to advertise products using different communications method, such as verbal, e-mails, etc. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that manufacturers and retailers of calcium-fortified products (see Mazer column 2, lines 39-60) would use all the available and affordable means to advertise to consumers the benefit of said products, so said consumers are aware of said benefits and purchase said products.

As per claim 5, Mazer teaches:

The method of claim 1, but fails to teach wherein the effect on body weight comprises preventing or reducing obesity. However, the same argument made in claim 1 is made in claim 5.

As per claim 6, Mazer teaches:

The method of claim 1, but fails to teach wherein the effect on body weight comprises preventing or reducing weight gain. However, the same argument made in claim 1 is made in claim 6.

As per claim 7, Mazer teaches:

The method of claim 1, but fails to teach wherein the effect on body weight comprises weight loss. However, the same argument made in claim 1 is made in claim 7.

As per claim 8, Mazer teaches:

The method of claim 1, but fails to teach wherein the effect on body weight comprises inducing a metabolic change in an individual. However, the same argument made in claim 1 is made in claim 8.

As per claim 9, Mazer teaches:

The method of claim 8, but fails to teach wherein the metabolic change comprises decreasing intracellular calcium concentrations ($[Ca^{2+}]_i$), stimulating lipolysis, inhibiting lipogenesis, increasing the expression of white adipose tissue uncoupling protein 2 (UCP2), reducing serum insulin levels, thermogenesis, or decreasing the levels of calcitrophic hormones. However, the same argument made in claim 1 is made in claim 9.

As per claim 10, Mazer teaches:

The method of claim 1, but fails to teach wherein the effect on body weight comprises preventing or reducing weight gain and/or adiposity in children. However, the same argument made in claim 1 is made in claim 10.

As per claim 11, Mazer teaches:

The method of claim 1, wherein the communication pertains to a class of products to which the calcium-containing product belongs (see column 2, lines 30-60).

As per claim 12, Mazer teaches:

The method of claim 1, wherein the product is a dairy product (see column 2, lines 37-60).

As per claim 13, Mazer teaches:

The method of claim 1, wherein the product is a dietary supplement (see column 3, lines 30-50).

As per claim 14, Mazer teaches:

The method of claim 1, wherein the product is a non-dairy foodstuff naturally high in calcium (see column 2, lines 37-60).

As per claim 15, Mazer teaches:

The method of claim 1, wherein the product is a foodstuff fortified with calcium (see column 2, lines 37-60).

As per claim 16, Mazer teaches:

The method of claim 1, wherein the product is selected from the group consisting of milk, yogurt and cheeses (see column 2, lines 37-60).

As per claim 17, Mazer teaches:

The method of claim 1, wherein the product is a liquid supplemented with calcium (see column 2, lines 37-60).

As per claim 18, Mazer teaches:

The method of claim 1, wherein the entity is the manufacturer of the product (see column 2, lines 37-60).

As per claim 19, Mazer teaches:

The method of claim 1, wherein the entity is a retailer of the product (see column 6, lines 44-56; "private sector is inherent that includes retailer of product").

As per claim 20, Mazer teaches:

The method of claim 1, wherein the entity is a trade association whose members sell the product (see column 6, lines 44-56; ("private sector is inherent that includes trade association").

As per claim 23, Mazer teaches:

The method of claim 22 but fails to teach wherein the distributed information recommends at least about 57 portions of dairy per month. However, Official Notice is taken that it is old and well known in the business art that companies with financial interest in selling their products would recommend a minimum amount of consumption of said products for the purpose of selling more of said products. It would have been obvious to a person of ordinary skill in the art at the time the application was made, that companies of dairy products would advertise that said dairy products would need to be consumed a certain number of times to obtain a certain benefit so said companies would generate more income from said consumption.

As per claim 26, Mazer teaches:

The method according to claim 24 wherein said information pertains to a class of products to which said calcium-containing product belongs (see column 2, lines 37-60).

As per claim 27, Mazer teaches:

The method according to claim 24, wherein said class of products is dairy products (see column 2, lines 37-60).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazer (US 5,698,222) in view of Hinz (US 6,403,657) and further in view of Christiansen (US 6,159,530) and Tannehill (US 5,158,310)..

As per claim 21, Mazer teaches:

The method of claim 1, but fails to teach wherein the product is identified by a trademark. However, Christiansen teaches a trademark calcium-fortified product (see Christiansen column 9, lines 20-35; "Calcium taste free"). Therefore, the same argument made in claim 1 is made in claim 21.

Conclusion


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The Examiner's Rightfax number is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
September 24, 2005


RAQUEL ALVAREZ
PRIMARY EXAMINER